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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/693,219	10/20/2000	Paul Lapstun	NPA031US	7823

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AUSTRALIA

EXAMINER

PHAM, THIERRY L

ART UNIT	PAPER NUMBER
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2625

DATE MAILED: 03/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/693,219

Applicant(s)

LAPSTUN ET AL.

Examiner

Thierry L. Pham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,6,7,15-18 and 22-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,6,7,15-18 and 22-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

- This action is responsive to the following communication: RCE filed on 1/27/06.
- Claims 1, 6-7, 15-18, 22-30 are pending in the application.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/27/06 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 6-7, 15-18, 22-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mori (US 6137590), and in view of Dymetman et al (US 6330976).

Regarding claim 18, Mori discloses a system enabling the copying of documents, the method including the steps of:

- a scanner for scanning (scanning using optical reader 28 or internally built optical reader, fig. 7, col. 6, lines 4-9) a document (document 10, fig. 7) that includes second visible markings (image data on document 10, fig. 7) not associated with digital inks, and first invisible coded data (barcode 10a using infrared and/or transparent toner, fig. 7, col. 13, lines 25-52) indicative of an identity (col. 1, lines 55-60) of the document, and forming a digital image (printing section 3, fig. 1) of the document;

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- a detector for detecting (detecting via barcode reader 28, fig. 7, col. 5, lines 10-45) the first coded data;
- a data store including data (accessing/retrieving electronic documents stored in storage section 4, fig. 6, col. 6, lines 8-10) representing the content of the document; and
- a printer adapted for printing (printer 14, fig. 7) using a printer a copy of the document including third visible markings (col. 8, lines 55-62), and, at the same time (col. 3, lines 58-62 and col. 8, lines 55-62), printing on the printed copy, using the same printer, second invisible (col. 13, lines 25-52) coded data document includes indicative of an identity of the copy (col. 13, lines 25-52).

However, Mori further teaches visible markings are duplicated on re-printed documents and coded data are may not be duplicated (col. 4, lines 25-30 and col. 9, lines 20-32) in re-printed document, but fails to teach and/or suggest digital inks and wherein markings associated with digital ink are duplicated and visible markings not associated with digital ink are not duplicated on the printed document.

Dymetman, in the same field of endeavor for embedding coded data, teaches digital inks (pointer 502 includes pen-like instrument for writing digital ink onto a coded substrate and/or any ordinary writing ordinary writing surface, figs. 1 & 9, col. 22, lines 10-65) and wherein markings with digital ink are duplicated and visible markings not associated with digital ink are not duplicated (facsimile apparatus as taught by Dymetman for faxing only messages written with digital inks, col. 22, lines 10-65) on the printed document.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify an image forming apparatus of Mori to include an apparatus of only duplicating markings associated with digital inks (e.g. digital inks are well known in the art as admitted by the applicants) as taught by Dymetman because of a following reason: (●) modifying image forming apparatus as taught by Mori to work with addition ink (i.e. digital inks via using stylus pen as taught by Dymetman and admitted the applicants) enhancing the overall capabilities of the image forming apparatus, for example, image forming apparatus as taught by Mori not only works with visible and invisible inks, but also with digital inks; (●) by only duplicating digital inks onto a printed document help reduces/saves other inks, thereby, reducing overall costs.

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Therefore, it would have been obvious to combine Mori with Dymetman to obtain the invention as specified in claim 18.

Regarding claim 22, Dymetman further teaches a sensing device operable by a user to identify said coded data printed on said copy (sensing device 502 for detecting/sensing coded data, figs. 1, 14-15, cols. 3-4 and col. 8, lines 45-67).

Regarding claim 23, Dymetman further teaches the sensing device including a marking nib (marking tip 505, fig. 11).

Regarding claim 24, Dymetman further teaches the sensing device including an identification means (network address of the sensing device, col. 9, lines 16-45), which imparts a unique identity to the sensing device, the system able to associate the identifier for the copy with the identity of the sensing device.

Regarding claims 25-26, the printer including a binder for binding pages of a multi-page copy and wherein scanner and the printer being provided as parts of a single apparatus (multifunctional copy machine including scanning, faxing, printing, and stapling functions are known in the art).

Regarding claim 27, Mori further discloses a system according to claim 18, the scanner and the detector being provided as parts of a single apparatus (col. 6, lines 5-43).

Regarding claim 28, Mori further discloses a system according to claim 27, the scanner comprising a moving linear image sensor device (col. 5, lines 10-45), the detector carried by this device.

Regarding claim 29, Dymetman further teaches the sensing device adapted to communicate with a base station (fig. 2 as per teaching of Dymetman), the scanner and base station (scanner, fig. 1, as per teachings of Tabata) provided as parts of a single apparatus.

Regarding claim 30, Mori further discloses a system according to claim 18 including authorization means to prevent use by an unauthorized user (password protection, col. 13, lines 20-23).

Regarding claims 1, 6-7, 15-17: Claims 1, 6-7, 15-17 are the methods corresponding the apparatus and recite limitations that are similar and in the same scope of invention as to those in claims 18, 22-30; therefore, claims 1, 6-7, 15-17 are rejected for the same rejection rationale/basis as described in claims 18, 22-30 above.

Response to Arguments

Applicant's arguments, see page 5, filed 11/23/05, with respect to claims 1 & 18 have been fully considered and are persuasive. The 112, 2nd paragraph rejection of claims 1 & 18 has been withdrawn.

Applicant's arguments, see pages 5-6, filed 11/23/05, with respect to the rejection(s) of claim(s) 1 & 18 under 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of newly found prior art reference.

Conclusion

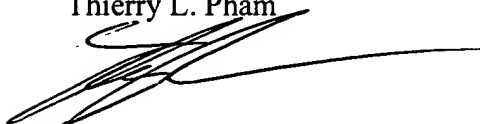
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L. Pham whose telephone number is (571) 272-7439. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thierry L. Pham



Gabriel Garcia
Primary Examiner
Gabriel Garcia